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FEB 28 2003

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Response

Serial No.: 09/865,612

Confirmation No.: 4697

Filed: May 25, 2001

For: METHODS, COMPLEXES, AND SYSTEMS FOR FORMING METAL-CONTAINING FILMS ON SEMICONDUCTOR STRUCTURES

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The Examiner took Official Notice of a chemical vapor deposition system. However, the Examiner failed to explicitly or impliedly take Official Notice of *every aspect* of the presently claimed invention (e.g., claims 18-38). For example, the Examiner failed to explicitly or impliedly take Official Notice that the chemical vapor deposition system includes a vessel containing *a precursor including one or more complexes of the formula: $[(R')NC(R^2)C(R^3)N(R')_2ML$* . Thus, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of anticipation of claims 18-38 under 35 U.S.C. §102(a).

Despite the lack of disclosure of *every aspect* of the presently claimed invention, the Examiner asserted that the "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" (page 2 of the Office Action mailed December 3, 2002), and cited as support *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). Applicant has attached a copy of *In re Young* as Exhibit A, the correct cite being 75 F.2d 996. Applicant respectfully traverses the Examiner's assertion.

Applicant respectfully disagrees with the Examiner's interpretation of *In re Young*. Specifically, in *In re Young*, the court was asked to rule if inclusion of the material being worked upon (i.e., concrete reinforced structures) as an element is, in itself, *a ground for rejection of a claim*. In fact, the court, in holding that claim 6 was *obvious* over the art of record, did not need to consider, and explicitly declined to rule on the above question. Moreover, Applicant respectfully submits that *In re Young* is distinguishable from the present case.

First, claims 18-38 of the present application are rejected under 35 U.S.C. §102(a) as being *anticipated* by the Examiner's Taking of Official Notice. Conversely, claim 6 of *In re Young* was found by the court to be *obvious* over the prior art, not *anticipated*: ("We do not understand the tribunals of the Patent Office to hold that the references cited of themselves constitute an anticipation of appellant's device, but rather it is held that, in view of them, no invention is involved." *In re Young*, F.2d at 998.). Applicant reiterates that "for anticipation

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under 35 U.S.C. 102, the reference must teach *every aspect* of the claimed invention either explicitly or impliedly." M.P.E.P. §706.02 (emphasis added).

Second, the M.P.E.P., in discussing *In re Young*, provides a direction for determining patentability by stating that "[t]he court held that the inclusion of the article formed within the body of the claim did not, *without more*, make the claim patentable" (M.P.E.P. §2215, emphasis added). Applicant respectfully submits that the present claims (e.g., chemical vapor deposition systems that include a precursor) can be distinguished from the claims discussed by *In re Young* (e.g., machines for making concrete beams including, as an element, the concrete reinforced structures). For example, there is nothing in the record of *In re Young* to indicate that the material being worked upon (i.e., the concrete reinforced structures), or methods of making or using the material being worked upon, were subject matter that would be patentable over the prior art. Conversely, the United States Patent and Trademark Office determined that methods reciting *a precursor composition including one or more complexes of the formula:*

$[(R^1)NC(R^2)C(R^3)N(R^4)]_xML$, (e.g., independent claims 1 and 15 of issued U.S. Pat. No. 6,281,124 (Vaartstra), the parent of the present application) were patentable over the art of record. Furthermore, the United States Patent and Trademark Office issues patents having claims directed to chemical vapor deposition systems that include a precursor (e.g., U.S. Pat. Nos. 6,306,217 and 6,444,041). Thus, in accordance with M.P.E.P. §2215, Applicant has provided reasoning for the patentability of the presently pending claims.

Based on the remarks presented herein above, Applicant respectfully submits that the taking of Official Notice by the Examiner fails to disclose *every aspect* of the claimed invention. Applicant respectfully requests that the Examiner reconsider and withdraw the rejection under 35 U.S.C. §102(a).

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Summary

It is respectfully submitted that all the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for

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February 28, 2003

Date

CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on this 28 day of February, 2003, at _____ (Central Time).

By:

Name: Jill R. Price

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IN RE YOUNG
75 F. (2d) 998

897

Jack of patentability in view of the prior art, and claim 6 upon the further ground that it includes the articles operated upon by the machines, that is, to quote from the claim, "concrete reinforced structures with longitudinal members connected by cross bars supported by suitable chairs on the said palette," as a part of the combination.

The brief for appellant states: "The machine is organized specifically for manufacturing reinforced I-beams having longitudinal metallic head and base reinforcing member with cross shear members."

The disclosure, in so far as here material, is of a device having a carriage, carried upon a track, the carriage being supported upon a detachable palette designed to serve as a mold for one side of the beam, while side and end members are designed to form the other parts of the mold. Into the mold there are placed reinforcing members comprising rods connected by vertical cross-bars, after which the concrete material is introduced from a hopper. The mold is then moved along the track beneath a series of stationary rollers. These rollers have ribs projecting from their middle portions, the width of the ribs increasing upon the successive rollers. It is the function of the rollers to compress the plastic concrete into proper form about the reinforcing members, and it is claimed that through the instrumentality of the successive mid-ribs the mix is kneaded in a manner which spreads it toward the head and base of the beam and there compacts it in a desirable manner. The completed beam is finally ejected upon the palette by plungers which act upon shoes underneath the palette.

The patent to Anderson is for a machine for the manufacture of building blocks. The disclosure is of a device having channels or troughs over which are operated carriages equipped with rollers. Molding material is introduced into the channels and when the rollers are rolled therethrough shapes are produced for casting cement blocks.

We do not find in this patent any teaching that the rollers operate upon the blocks themselves in the process of molding or shaping them. The sole function of Anderson's rollers seems to be that of compressing the sand or other molding material in the trough so as to form the shapes into which the blocks are ultimately to be molded.

We feel, therefore, that the Anderson patent has little if any relation to the device of appellant.

The patent to Craig is for a block-making machine and apparently was cited principally because of its showing relating to the ejection of the finished blocks by the elevation of bars actuated by cams rolling over cam tracks.

With the possible exception of claim 4, *supra*, we do not find the ejection element defined in any of the claims on appeal, although the brief for appellant alludes to claims 5 and 6 as also containing it. It seems to be present in one or more of the allowed claims.

The Craig patent, it is believed, substantially anticipates the ejection feature of appellant's device. This fact, however, under the rule stated by this court in the case of *In re Luks*, 69 F. (2d) 552, 21 C. C. P. A. (Patents) 1005, would not of itself defeat appellant's combination claims, if found otherwise patentable.

The patent to Trevillian relates to an apparatus for molding plastic materials, "such as are used in the manufacture of tile, bricks, coping, etc."

Palettes of whatever configuration may be necessary to manufacture the particular form of article desired are provided, these to be carried upon a flanged-wheel conveyor. The material to be molded is conveyed to the palettes through a hopper, and the conveyor, traveling upon guides, moves the loaded palettes forward under mechanisms which perform the various operations upon the material that are required to produce the desired article, these operations being defined in the specification as "leveling," "tamping," "troweling," "smoothing," and "finishing."

The mechanism for the finishing operation seems to be the feature of the Trevillian device regarded by the tribunals of the Patent Office as substantially anticipating appellant's mid-rib rollers. In this feature there is disclosed a roller mounted upon a shaft; the roller, as shown in the drawings, having enlarged portions or ribs, its ends being flanged and so arranged in relation to the palette as to shear off the edges of the product in a smooth manner.

It does not appear that the rollers of the Trevillian device, above alluded to, perform any function in the actual shaping or molding of the articles which it is designed to produce. Trevillian's specification recites that: "Preferably the roll is revolved at a comparatively low speed in a direction counter to that of the travel of the product

at the point of contact, so as to produce a very smoothly finished surface."

It appears from a study of his patent that Trevillian's rollers merely operate to finish or smooth the surfaces of articles which have been already shaped by the preceding operations.

Such appears to be the finding of the Examiner, which was approved by the Board of Appeals, but the Examiner says: "However, it is held that even smoothing necessarily necessitates some displacement of material, however slight that displacement might be."

The Examiner also calls attention to the fact that certain of the claims on appeal, such as No. 9, merely call for a roller with a mid-rib section thereon followed by a statement of function.

We do not understand the tribunals of the Patent Office to hold that the references cited of themselves constitute an anticipation of appellant's device, but rather it is held that, in view of them, no invention is involved.

The board says: "We can see no invention in employing a roller molding action for the upper portion of a beam and we agree with the examiner that it would be obvious to those skilled in the art that a plurality of rollers of different shapes may be employed when it is not expedient to complete the molding action with one roller."

We regard the foregoing as a correct statement, and a careful analysis of the appealed claims leads us to the conclusion that any structure which they specify, that is not included in the allowed claims, is structure designed for none other than the operation as described in the statement.

It is true that claim 6, *supra*, does include as an element the material being worked upon; that this was one ground upon which the Examiner rejected it, and that the board approved such ground.

We do not deem it necessary to determine whether, were the claim otherwise patentable, the inclusion of this limitation should of itself prevent its allowance, but we do hold that its inclusion may not lend patentability, since the claim is not otherwise allowable.

The decision of the Board of Appeals is affirmed.

Affirmed.

U. S. C. P. A. (Patents)
WEMPLE et al. v. PEIRCE et al.
Patent Appeal No. 3441.

Court of Customs and Patent Appeals,
March 25, 1935.

1. Patents \Rightarrow 106(2)

Counts of interference held within range of applications for patent for zinc base alloy, though specifications of respective applications defined different results.

2. Patents \Rightarrow 191

Party securing patent is entitled to protection in use of all substantial parts of ranges covered.

3. Patents \Rightarrow 113(4)

Part of brief containing quotations from other applications not involved on appeal in patent interference proceeding, and not made part of record, should be disregarded.

Appeal from Board of Appeals of United States Patent Office, Interference No. 62,666.

Interference proceeding between Leland E. Wemple and another, junior parties, and Willis M. Peirce and another, senior parties. The decision of the Examiner of Interferences awarding priority of invention to the senior parties was affirmed by the Board of Appeals of the United States Patent Office, and the junior parties appeal.

Affirmed.

Bailey & Larson, of Washington, D. C. (Roberts B. Larson and Jennings Bailey, Jr., both of Washington, D. C., of counsel), for appellants.

Merton W. Sage, of New York City (C. M. Fisher, of Washington, D. C., of counsel), for appellees.

Before GRAHAM, Presiding Judge, and BLAND, HATFIELD, GARRETT, and LENROOT, Associate Judges.

GARRETT, Associate Judge.

This is an appeal in an interference proceeding wherein the Board of Appeals of the United States Patent Office affirmed the decision of the Examiner of Interferences awarding priority of invention to appellees.

Three counts are involved. They read as follows:

"1. A zinc base alloy consisting principally of zinc containing from 1-2% of Cu